

01-24-02

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**UTILITY PATENT APPLICATION TRANSMITTAL
(Small Entity)**

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Docket No.
18810-81606Total Pages in this Submission
106**TO THE ASSISTANT COMMISSIONER FOR PATENTS**Box Patent Application
Washington, D.C. 20231

Transmitted herewith for filing under 35 U.S.C. 111(a) and 37 C.F.R. 1.53(b) is a new utility patent application for an invention entitled:

Transfection, Storage and Transfer of Male Germ Cells for Generation of Transgenic Species

and invented by:

Carol W. Readhead and Robert Winston

J1046 U.S. PTO

10/054365



11/12/01

If a **CONTINUATION APPLICATION**, check appropriate box and supply the requisite information:☐ Continuation ☒ Divisional ☐ Continuation-in-part (CIP) of prior application No.: 09/191,920

Claims benefit of provisional : 60/065,825

☐ Continuation ☐ Divisional ☐ Continuation-in-part (CIP) of prior application No.: _____

Enclosed are:

Application Elements☐ Filing fee as calculated and transmitted as described below2. ☒ Specification having 47 pages and including the following:

- a. ☒ Descriptive Title of the Invention
- b. ☒ Cross-References to Related Applications (if applicable)
- c. ☐ Statement Regarding Federally-sponsored Research/Development (if applicable)
- d. ☐ Reference to Microfiche Appendix (if applicable)
- e. ☒ Background of the Invention
- f. ☒ Brief Summary of the Invention
- g. ☒ Brief Description of the Drawings (if drawings filed)
- h. ☒ Detailed Description
- i. ☒ Claim(s) as Classified Below
- j. ☒ Abstract of the Disclosure

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106

Application Elements (Continued)

3. ☐ Drawing(s) *(when necessary as prescribed by 35 USC 113)*
a. ☐ Formal b. ☐ Informal Number of Sheets _____
4. ☒ Oath or Declaration
a. ☐ Newly executed *(original or copy)* ☐ Unexecuted
b. ☒ Copy from a prior application (37 CFR 1.63(d)) *(for continuation/divisional application only)*
c. ☐ With Power of Attorney ☒ Without Power of Attorney
d. ☐ DELETION OF INVENTOR(S)
Signed statement attached deleting inventor(s) named in the prior application,
see 37 C.F.R. 1.63(d)(2) and 1.33(b).
5. ☐ Incorporation By Reference *(usable if Box 4b is checked)*
The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under
Box 4b, is considered as being part of the disclosure of the accompanying application and is hereby
incorporated by reference therein.
6. ☐ Computer Program in Microfiche
7. ☐ Genetic Sequence Submission *(if applicable, all must be included)*
a. ☐ Paper Copy
b. ☐ Computer Readable Copy
c. ☐ Statement Verifying Identical Paper and Computer Readable Copy

Accompanying Application Parts

8. ☒ Assignment Papers *(cover sheet & documents)*
9. ☒ 37 CFR 3.73(b) Statement *(when there is an assignee)*
10. ☐ English Translation Document *(if applicable)*
11. ☐ Information Disclosure Statement/PTO-1449 ☐ Copies of IDS Citations
12. ☐ Preliminary Amendment
13. ☒ Acknowledgment postcard
14. ☒ Certificate of Mailing
☐ First Class ☒ Express Mail *(Specify Label No.):* EL 900688434 US

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(Only for new nonprovisional applications under 37 CFR 1.53(b))

Docket No.
18810-81606

Total Pages in this Submission

106

Accompanying Application Parts (Continued)

15. ☐ Certified Copy of Priority Document(s) (if foreign priority is claimed)
16. ☒ Small Entity Statement(s) - Specify Number of Statements Submitted: 2
17. ☒ Additional Enclosures (please identify below):

Copies of Power of Attorney by Assignee, Notice of Change of Address Preliminary Amendment and Petition Under § 1.48(b)(1) for Correction of Inventorship; and Revocation of Prior Powers and New Power of Attorney

Request That Application Not Be Published Pursuant To 35 U.S.C. 122(b)(2)

18. ☐ Pursuant to 35 U.S.C. 122(b)(2), Applicant hereby requests that this patent application not be published pursuant to 35 U.S.C. 122(b)(1). Applicant hereby certifies that the invention disclosed in this application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing of the application.

Warning

An applicant who makes a request not to publish, but who subsequently files in a foreign country or under a multilateral international agreement specified in 35 U.S.C. 122(b)(2)(B)(i), must notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

UTILITY PATENT APPLICATION TRANSMITTAL
(Small Entity)

(Only for new nonprovisional applications under 37 CFR 1.53(b))

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106

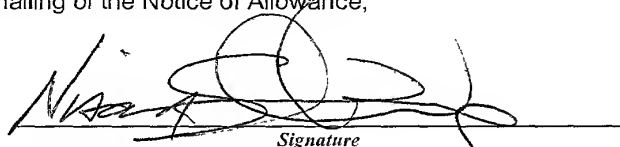
Fee Calculation and Transmittal

CLAIMS AS FILED

For	#Filed	#Allowed	#Extra	Rate	Fee
Total Claims	48	- 20 =	28	x \$9.00	\$252.00
Indep. Claims	3	- 3 =	0	x \$42.00	\$0.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					\$0.00
BASIC FEE					\$370.00
OTHER FEE (specify purpose)					\$0.00
TOTAL FILING FEE					\$622.00

- ☐ A check in the amount of _____ to cover the filing fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge and credit Deposit Account No. 50-1597 as described below. A duplicate copy of this sheet is enclosed.
- ☒ Charge the amount of \$622.00 as filing fee.
 - ☒ Credit any overpayment.
 - ☒ Charge any additional filing fees required under 37 C.F.R. 1.16 and 1.17.
 - ☐ Charge the issue fee set in 37 C.F.R. 1.18 at the mailing of the Notice of Allowance, pursuant to 37 C.F.R. 1.311(b).

Dated: November 12, 2001


Signature

Nisan A. Steinberg, Ph.D.
Registration No. 40,345
SIDLEY AUSTIN BROWN & WOOD
555 West Fifth Street
Los Angeles, CA 90013-1010
Ofc: 213/896-6170
Fax: 213/896-6665

cc:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Dated: March 19, 1999

In re application of: Readhead et al.
 Serial No 09/191,920
 Filed: November 13, 1998
 For: TRANSFECTION STORAGE AND TRANSFER OF MALE GERM
 CELLS FOR GENERATION OF TRANSGENIC SPECIES &
 GENETIC THERAPIES
 Examiner: Unassigned
 Unit: 1643

PETITION UNDER § 1.48(b)(1) FOR
CORRECTION OF INVENTORSHIP

Assistant Commissioner for
 Patents
 Washington, D. C. 20231

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO THE ASSISTANT COMMISSIONER FOR PATENTS WASHINGTON, D C 20231 ON <u>March 19, 1999</u>	
BY <u>[Signature]</u>	DATE <u>March 19, 1999</u>
ANN WEISS	
March 19, 1999	
DATE OF SIGNATURE	

Dear Sir:

Applicants respectfully petition for correction of the inventorship of the above-captioned utility patent application. Specifically, the deletion of the name of **OUTI HOVATTA**. The Applicants acknowledge that Outi Hovatta's invention is no longer being claimed in the application due to the cancellation of claims 126 through 130 and the amendment of claim 114 in a Preliminary Amendment filed herewith.

The requisite fee of \$130.00 under 37 C.F.R. § 1.17(i) is made herewith in compliance with 37 C.F.R. § 1.48(b)(2). The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required, or to credit any

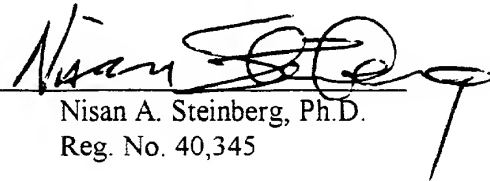
1009443345001

overpayment, to Deposit Account No. 16-2460. A duplicate copy of this petition is enclosed.

Respectfully submitted,

PRETTY, SCHROEDER & POPLAWSKI

By:



Nisan A. Steinberg, Ph.D.
Reg. No. 40,345


444 South Flower Street -19th Floor
Los Angeles, California 90071-2909
Ofc: 213/ 622-7700
Fax: 213/489-4210
ODMA\PCDOCS\DOCS\416\1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Readhead et al.
 Serial No. 09/191,920
 Filed: November 13, 1998
 For: Transfection, Storage and Transfer of Male Germ Cells for
 Generation of Transgenic Species & Genetic Therapies
 Examiner: Clark, D.
 Unit: 1633

NOTICE OF CHANGE OF ADDRESS

Assistant Commissioner for Patents
 Washington, D. C. 20231

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO THE ASSISTANT COMMISSIONER FOR PATENTS	
WASHINGTON, D. C. 20231, ON	November 14, 2000
BY 	DATE
ANN WEISS	November 14, 2000
	(DATE OF SIGNATURE)

Dear Sir:

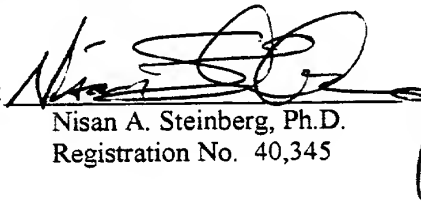
Please take notice that, effective immediately, Applicants' attorney of record has changed his address and telephone number. Please send all correspondence regarding the above-referenced application to:

Edward G. Poplawski, Esq.
 Registration No. 33,439
 Sidley & Austin
 A Partnership including Professional Corporation
 555 West Fifth Street
 Los Angeles, CA 90013-1010

Please refer all calls to Nisan A. Steinberg, Ph.D., Registration No. 40,345 at 213/896-6665.

Respectfully submitted,

SIDLEY & AUSTIN

By: 
 Nisan A. Steinberg, Ph.D.
 Registration No. 40,345

555 West Fifth Street
 Los Angeles, California 90013-1010
 Ofc: 213/ 896-6665
 Fax: 213/896-6600

40054365 11201
 2025-11-14

CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)

Applicant(s): Carol W. Readhead, robert winston, and Outi Hovatta

Docket No.

P07 41794

Serial No.
NOT ASSIGNEDFiling Date
NOVEMBER 13, 1998Examiner
NOT ASSIGNEDGroup Art Unit
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Invention:

Transfection, Storage and Transfer of Male Germ Cells for Generation of Transgenic Species & Genetic Therapies

I hereby certify that this Statement Claiming Small Entity Status
(Identify type of correspondence)

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under
37 CFR 1.10 in an envelope addressed to: The Assistant Commissioner for Patents, Washington, D.C. 20231 on
November 13, 1998
(Date)

ANN WEISS

(Typed or Printed Name of Person Mailing Correspondence)


(Signature of Person Mailing Correspondence)EL 149 134 734 US

("Express Mail" Mailing Label Number)

Note: Each paper must have its own certificate of mailing.

10054365-11294

CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)			Docket No. P07 41794	
Applicant(s): Carol W. Readhead, robert winston, and Outi Hovatta				
Serial No. NOT ASSIGNED	Filing Date NOVEMBER 13, 1998	Examiner NOT ASSIGNED	Group Art Unit --	
Invention: Transfection, Storage and Transfer of Male Germ Cells for Generation of Transgenic Species & Genetic Therapies				
<p>I hereby certify that this <u>Power of Attorney By Assignee Under Rule 32</u> (Identify type of correspondence)</p> <p>is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: The Assistant Commissioner for Patents, Washington, D.C. 20231 on <u>November 13, 1998</u> (Date)</p> <p><u>ANN WEISS</u> (Typed or Printed Name of Person Mailing Correspondence)</p> <p><u>[Signature]</u> (Signature of Person Mailing Correspondence)</p> <p><u>EL 149 134 734 US</u> (Express Mail Mailing Label Number)</p>				
Note: Each paper must have its own certificate of mailing.				